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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,629	04/12/2007	Peter Gaal	030263	9203
23596 7590 09/30/2010 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
EXAMINER				
ISSING, GREGORY C				
ART UNIT		PAPER NUMBER		
3662				
NOTIFICATION DATE		DELIVERY MODE		
09/30/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com

### Office Action Summary

**Application No.**

10/554,629

**Applicant(s)**

GAAL ET AL.

**Examiner**

Gregory C. Issing

**Art Unit**

3662

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-61 is/are pending in the application.
- 4a) Of the above claim(s) 34-44, 47-52, 54-59 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45, 46, 53 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 6/16/10 has been entered.

2. Claims 1-33 have been cancelled in the prosecution history. Applicants' list of claims incorrectly lists the status of the claims as "withdrawn."

3. The allowed invention was directed to a method and apparatus for "evaluating the validity of previously obtained acquisition assistance data for use in acquiring a particular signal" by comparing lists of base stations. The newly drawn claims are directed to a different and separate invention for "evaluating location-sensitive information" by comparing lists of base stations. Since the applicants have received an examination on the previous invention, the claims drawn solely to "evaluating the validity of location sensitive information" are withdrawn as being directed to a separate invention. Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right, see 37 CFR 1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered.

4. The claims represent a distinct invention since it is not evident from the specification that evaluating a validity of previously obtained acquisition assistance data for use in acquiring a particular signal is the same as evaluating a validity of previously obtained location sensitive

information. The specification describes “location-sensitive information” as BS almanac or repeater almanac [00073].

5. Claims 45, 46, 53 and 60 are pending.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 45, 46, 53 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Each of the claims concludes with the step of “evaluating a validity”. This amounts to a mental judgement with no particular meaning and no particular result. Previously, the claims recited the particular result for acquiring a particular signal. However as written now, there is no particular meaning to “evaluating a validity.”

9. In view of the desire for compact prosecution, the following is provided. Should applicants prove that the claims are not independent and distinct, it is noted that claims 34-38, 46, 47, and 55-61 would be rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 34-38, 46 and 47 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below: the claims fail the machine or transformation test and the mechanism by which the method is implemented is subjective or imperceptible since it represents a mental activity of looking at two lists and making a judgement.

11. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 55-61 are held to be no statutory since it is not clear what statutory category the claim is intended to be. The claim sets forth "an apparatus," but lacks any structural limitations since the body of the claims merely sets out functional steps.
12. Moreover, for reasons set forth with respect to the rejection under 35 USC 112, 2<sup>nd</sup> par., should applicants prove that the all of the claims are not independent and distinct, it is noted that claims 34-44, 47-52 and 54-59 and 61 would also be rejected under 35 U.S.C. 112, 2<sup>nd</sup> par.
13. Lastly, as the instantly withdrawn claims merely obtain lists of base stations and compare the lists (since the step of evaluating is nothing more than a mental judgement, the document cited by the applicants (EP 0541026) would anticipate the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory C. Issing/  
Primary Examiner  
Art Unit 3662

gci